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09/697,233	10/26/2000	Joseph T. Pych	NMC-003.01	3470

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EXAMINER
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ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

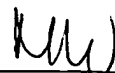|	Application No.	Applicant(s)
Office Action Summary	09/697,233	PYCH, JOSEPH T.
	Examiner	Art Unit
	Akiba K Robinson-Boyce	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *19 May 2004*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14,17,18,33-43,45-53,56 and 57* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14,17,18,33-43,45-53,56 and 57* is/are rejected.

7) ☒ Claim(s) *17 and 56* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   Due to communications filed 5/19/04, the following is a final office action.

Claims 15, 16, 19-32, 44, 54 and 55 have been cancelled. Claims 1, 2, 5, 6, 8-

10, 14, 17, 18, 33-36, 38, 39, 45-48, 50, 53, 56 and 57 have been amended.

Claims 1-14, 17, 18, 33-43, 45-53, 56 and 57 are pending in this application and

have been examined on the merits. Claims 1-14, 17, 18, 33-43, 45-53, 56 and

57 are rejected as follows.

Claim Objections

2.   Claims 17 and 56 are objected to because of the following informalities:

The both depend on cancelled claims. As per claim 17, this claim depends on

cancelled claim 15, therefore the examiner will re-assign this claim as being

depended on independent claim 14. As per claim 56, this claim depends on

cancelled claim 54, therefore the examiner will re-assign this claim as being

depended on independent claim 53.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

4.   Claims 1, 3-9, 11-14, 17, 18, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Saxe (US 5,636,346), and further in view of Heinly (NAHB

Conferees Explore strategies to cope with a market revolution).

As per claim 1, Saxe discloses:

Providing a database of prospect lists, in which each prospect list is

associated with (i)at least one list purchaser who used the prospect list and, (Col.

12, lines 42-45, [matching with the database to identify target subscriber listing])

(ii) for each list purchaser who used the prospect list, data that indicates whether

the list was successful based on feedback from the list purchaser, (Col. 8, lines

59-65, [subscriber responses provided represents feedback, list of respondees to

targeted advertisements identified by a buy number who desire product

information indicates a successful list]);

Identifying, in the database of prospect lists, one or more successful lists

of prospective customers in which each such list was used by the first list

purchaser and is associated with data indicating that the list was successful for

the first list purchaser based on feedback from the first list purchaser, (Col. 12,

lines 42-45, [matching with the database to identify target subscriber listing

where the subscriber represents the customer], Col. 8, lines 48-65, [viewers

{subscribers} may interface with the cable medium in order to interact where

appropriate, and responses are captured on a file server, thereby allowing viewer

{subscriber} access to this response information. In addition, the subscriber

responses provided represents feedback, and the list of respondees to targeted

advertisements identified by a buy number who desire product information

indicates a successful list]);

For each of the at least one other list purchaser, identifying, in the

database of prospect lists, one or more successful lists of prospective customers

in which each such list was used by the list purchaser and is associated with data

indicating that the list was successful for the list purchaser based on feedback

from the list purchaser, (Col. 8, lines 48-65, [shows that viewers {subscribers}

may interface with the cable medium in order to interact where appropriate, and

responses are captured on a file server, thereby allowing viewer {subscriber}

access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted

advertisements identified by a buy number who desire product information

indicates a successful list]); and

providing access to the first list purchaser to a targeted list of prospective

customers, the targeted list including one or more of the successful lists of

prospective customers identified for the first list purchaser and one or more of the

successful lists identified for at least one of the at least one other list purchasers,

(Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13,

lines 60-62, [transmitting the commercial information [represents the list]).

Saxe does not specifically disclose "identify, from the database of

prospect lists, at least one other list purchaser who used one or more of the one

or more successful lists identified for the first list purchaser". However, Saxe

would have incorporated this feature with the motivation of submitting a

successfully represented list that reflects products or services that customers

"would purchase" and that purchasers have previously used.

However, Heinly discloses:

identify, from the database of prospect lists, at least one other list

purchaser who used one or more of the one or more successful lists identified for

the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect

list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the

purpose of showing that a prospect list can be determined from previous

successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of

the applicant's invention to identify from the database of prospect lists, at least

one other list purchaser who used one or more of the one or more successful

lists identified for the first list purchaser with the motivation of using list

purchasers to find prospect customers that would purchase certain product and

services, and would be the best candidates to target.

As per claim 3, Saxe discloses:

removing duplicate prospective customers from the targeted list of

prospective customers, (Col. 10, line 48, [eliminating duplicate list]).

As per claim 4, Saxe discloses:

wherein the database of prospective customers is a computer database

available over a computer network via client computers to a plurality of list

purchasers, (Fig. 1).

As per claim 5, Saxe discloses:

distributing the targeted list of prospective customers to the first list

purchaser, (Col. 3, lines 3-13, [distributors advertising messages and accessing

targeted subscribers]).

As per claims 6, Saxe discloses:

distributing the targeted list of prospective customers to a third party

associated with the first list purchaser,(Col. 13, lines 8-61, [shows process for

third party source]).

As per claim 7, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the

first list purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 8, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on

a storage medium and delivers the storage medium to the first list purchaser,

(Col. 4, lines 7-14, [subscriber data stored]).

As per claim 9, Saxe discloses:

Communicate with a database of prospect lists, in which each prospect list

is associated with (i) at least one list purchaser who used the prospect list and (ii)

for each list purchaser who used the prospect list data that indicated whether the

list was successful based on feedback from the list purchaser, (Col. 12, lines 42-

45, [matching with the database to identify target subscriber listing]) (ii) for each

list purchaser who used the prospect list, data that indicates whether the list was

successful based on feedback from the list purchaser, (Col. 8, lines 59-65,

[subscriber responses provided represents feedback, list of respondees to

targeted advertisements identified by a buy number who desire product

information indicates a successful list]);

identify, in the database of prospect lists, one or more successful lists of

prospective customers in which each such list was used by a first list purchaser

and is associated with data indicating that the list was successful for the first list

purchased based on feedback from the first list purchaser, (Col. 12, lines 42-45,

[matching with the database to identify target subscriber listing, (Col. 12, lines 42-

45, [matching with the database to identify target subscriber listing where the

subscriber represents the customer], Col. 8, lines 48-65, [viewers {subscribers}

may interface with the cable medium in order to interact where appropriate, and

responses are captured on a file server, thereby allowing viewer {subscriber}

access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted

advertisements identified by a buy number who desire product information

indicates a successful list]);

for each of the at least one other list purchaser, identify, in the database of

prospect lists, one or more successful lists of prospective customers in which

each such list was used by the list purchaser and is associated with data

indicating that the list was successful for the list purchaser based on feedback

from the list purchaser, (Col. 8, lines 48-65, [shows that viewers {subscribers}

may interface with the cable medium in order to interact where appropriate, and

responses are captured on a file server, thereby allowing viewer {subscriber}

access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted

advertisements identified by a buy number who desire product information

indicates a successful list])

provide access to the first list purchaser to a targeted list of prospective

customers, the targeted list including one or more of the successful lists of

prospective customers identified for the first list purchaser and one or more of the

successful lists identified for at least one of the at least one other list purchasers,

(Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13,

lines 60-62, [transmitting the commercial information [represents the list]).

Saxe does not specifically disclose "identify from the database of prospect

lists, at least one other list purchaser who used one or more of the one or more

successful lists identified for the first list purchaser". However, Saxe would have

incorporated this feature with the motivation of submitting a successfully

represented list that reflects products or services that customers "would

purchase" and that purchasers have previously used.

However, Heinly discloses:

identify from the database of prospect lists, at least one other list

purchaser who used one or more of the one or more successful lists identified for

the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect

list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify from the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 11, Saxe discloses:

remove duplicate prospective customers from the targeted list of prospective customers, (Col. 10, line 48, [eliminating duplicate list]).

As per claim 12, Saxe discloses:

wherein the database is a computer database of prospective customers available over a computer network via client computers to a plurality of list purchasers, (Fig. 1).

As per claim 13, Saxe discloses:

wherein the database of prospective customers is coupled to the computer over a computer network, (Fig. 1).

As per claim 14, Saxe discloses:

a server computer hosting a prospect list service accessible via client computers to a plurality of list purchasers, (col. 8, line 52, [file server]); and

a database of prospect lists, in which each prospect list is associated with

(i) at least one list purchaser who used the prospect list, (Col. 12, lines 32-45,

[matching with the database to identify target subscriber listing]) and (ii) for each

list purchaser who used the prospect list, data that indicates whether the list was

successful based on feedback from the list purchaser; (Col. 8, lines 59-65,

[subscriber responses provided represents feedback, list of respondees to

targeted advertisements identified by a buy number who desire product

information indicates a successful list]);

the prospect list service being configured so as to:

Identify, in the database of prospect lists, at least one other list purchaser

who used on e or more of the one or more successful lists identified for the first

list purchaser, (Col. 12, lines 42-45, [matching with the database to identify target

subscriber listing, (Col. 12, lines 42-45, [matching with the database to identify

target subscriber listing where the subscriber represents the customer], Col. 8,

lines 48-65, [viewers {subscribers} may interface with the cable medium in order

to interact where appropriate, and responses are captured on a file server,

thereby allowing viewer {subscriber} access to this response information. In

addition, the subscriber responses provided represents feedback, and the list of

respondees to targeted advertisements identified by a buy number who desire

product information indicates a successful list]);

For each of the at least one other list purchaser, identify, in the database

of prospect lists, one or more successful lists of prospective customers in which

each such list was used by the list purchaser and is associated with data

indicating that the list was successful for the list purchaser based on feedback for

the list purchaser, (Col. 8, lines 48-65, [shows that viewers {subscribers} may

interface with the cable medium in order to interact where appropriate, and

responses are captured on a file server, thereby allowing viewer {subscriber}

access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted

advertisements identified by a buy number who desire product information

indicates a successful list]); and

Provide access to the first list purchaser to a targeted list of prospective

customers, the targeted list including one or more of the successful list of

prospective customers identified for the first list purchaser and one or more of the

successful lists identified for at least one of the at least one other list purchaser,

(Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13,

lines 60-62, [transmitting the commercial information [represents the list]).

Saxe fails to disclose "identify in the database of prospect lists, at least

one other list purchaser who used one or more of the one or more successful

lists identified for the first list purchaser". However, Saxe would have

incorporated this feature with the motivation of submitting a successfully

represented list that reflects products or services that customers "would

purchase" and that purchasers have previously used.

However, Heinly discloses:

identify in the database of prospect lists, at least one other list purchaser

who used one or more of the one or more successful lists identified for the first

list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 17, Saxe discloses:

wherein the prospect list service identifies at least one of the at least one list purchaser based on additional predetermined criteria relating the at least one of the at least one other list purchaser to the first list purchaser, (Col. 7, lines 5-7, [preselected criteria]).

As per claim 18, Saxe discloses:

wherein the predetermined criteria concerns a business of the first list purchaser and the at least one of the at least one other list purchaser, (Col. 7, lines 7-9, [trading area]).

5.   Claims 2, 10, 36, 48, 53, 56-57, are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe (US 5,636,346), and further in view of Heinly

(NAHB Conferees Explore Strategies to Cope With a Market Revolution), and further view of Wright et al (US 6,004,276).

As per claim 2, both Saxe and Heinly fail to disclose ranking the prospect lists identified in the database and associated with the at least one other list purchaser based on predetermined factors. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

ranking the prospect lists identified in the database and associated with the at least one other list purchaser based on predetermined factors, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 10, both Saxe and Heinly fail to disclose rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer

requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 36, both Saxe and Heinly fail to disclose ranking the at least one other prospect list identified in the computer database based on predetermined factors. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

ranking the at least one other prospect list identified in the computer database based on predetermined factors, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 48, both Saxe and Heinly fail to disclose rank the at least one other prospect list identified in the computer database based on predetermined factors. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the at least one other prospect list identified in the computer database based on predetermined factors, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 53, Saxe discloses:

means for storing a database of prospect lists, (Col. 14, lines 29-31,

[means recorded on said recording medium for creating a database])in which

each prospect list is associated with (i) at least one list purchaser who used the

prospect list, (Col. 12, lines 32-45, [matching with the database to identify target

subscriber listing]) and (ii) for each list purchaser who used the prospect list,

data that indicates whether the list was successful based on feedback from the

list purchaser, (Col. 8, lines 59-65, [subscriber responses provided represents

feedback, list of respondees to targeted advertisements identified by a buy

number who desire product information indicates a successful list]);

means for providing a user interface comprising controls whereby a list

purchaser can access information concerning prospect lists stored in the

database, ([cable medium]);

means for generating the targeted list for the first list purchaser, (col. 14,

lines 47-53, [means for controlling the transmission to target subscribers], the

means being configured to:

Identify, in the database of prospect lists, at least one other list purchaser

who used on e or more of the one or more successful lists identified for the first

list purchaser, (Col. 12, lines 42-45, [matching with the database to identify target

subscriber listing, (Col. 12, lines 42-45, [matching with the database to identify

target subscriber listing where the subscriber represents the customer], Col. 8,

lines 48-65, [viewers {subscribers} may interface with the cable medium in order

to interact where appropriate, and responses are captured on a file server,

thereby allowing viewer {subscriber} access to this response information. In

addition, the subscriber responses provided represents feedback, and the list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list]);

For each of the at least one other list purchaser, identify, in the database of prospect lists, one or more successful lists of prospective customers in which each such list was used by the list purchaser and is associated with data indicating that the list was successful for the list purchaser based on feedback for the list purchaser, (Col. 8, lines 48-65, [shows that viewers {subscribers} may interface with the cable medium in order to interact where appropriate, and responses are captured on a file server, thereby allowing viewer {subscriber} access to this response information. In addition, the subscriber responses provided represents feedback, and the list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list]); and

Provide access to the first list purchaser to a targeted list of prospective customers, the targeted list including one or more of the successful list of prospective customers identified for the first list purchaser and one or more of the successful lists identified for at least one of the at least one other list purchaser, (Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

Saxe fails to disclose a network interface for connecting the computer system to a computer network, the computer system being accessible over the computer network via client computers to a plurality of list purchasers. Saxe

would have included this limitation with the motivation of showing a means or some type of specific hardware for providing an interface.

However Wright et al discloses:

a network interface for connecting the computer system to a computer network, the computer system being accessible over the computer network via client computers to a plurality of list purchasers, (Col. 29, line 65, [inter-network interface]).

Wright et al shows the above limitation in an analogous art for the purpose of showing the specific piece of hardware used to create the interface environment.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have a network interface for connecting the computer system to a computer network to the computer system being accessible over the computer network via client computers to a plurality of list purchasers with the motivation of providing a connection point for interfacing with the internet.

Saxe fails to disclose "identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser". However, Saxe would have incorporated this feature with the motivation of submitting a successfully represented list that reflects products or services that customers "would purchase" and that purchasers have previously used.

However, Heinly discloses:

identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 56, Saxe discloses:

wherein the means for generating the targeted list is configured to identify at least one of the at least one other list purchaser based on additional predetermined criteria relating the at least one of the at least one other list purchaser to the first list purchaser, (Col. 7, lines 5-7, [preselected criteria]).

As per claim 57, Saxe discloses:

wherein the predetermined criteria concerns a business of the first list purchaser and the at least one of the at least one other list purchaser, (Col. 7, lines 7-9, [trading area]).

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 33-35, 37-43, 45-47, 49-51, are rejected under 35 U.S.C. 102(b)

as being anticipated by Saxe (US 5,636,346).

As per claim 33, Saxe discloses:

identifying, in a computer database of prospect lists, a successful list of

prospective customers that was used by the first list purchaser and that is

associated with data indicating that the list was successful for the first list

purchaser based on feedback from the first list purchaser, (Col. 12, lines 32-45,

[matches with the database to identify target subscriber listing, (Col. 8, lines 59-

65, [subscriber responses provided represents feedback, list of respondees to

targeted advertisements identified by a buy number who desire product

information indicates a successful list]);

identifying, in the computer database, at least one other prospect list that

includes at least one of the prospective customers included in the successful list

of prospective customers for the first list purchaser, (Col. 12, lines 48-51,

[commercial information being transmitted to the subscriber], (Col. 13, lines 42-

50, [where successful prospect lists are represented by the target subscriber lists

that matches the customer information], (Col. 12, lines 42-45, [matching with the

database to identify target subscriber listing where the subscriber represents the

customer], Col. 8, lines 48-65, [viewers {subscribers} may interface with the cable

medium in order to interact where appropriate, and responses are captured on a

file server, thereby allowing viewer {subscriber} access to this response

information. In addition, the subscriber responses provided represents feedback,

and the list of respondees to targeted advertisements identified by a buy number

who desire product information indicates a successful list]); and

providing access to a targeted list of prospective customers, including one

or more prospective customers from the set of additional prospect list, to the first

list purchaser, (Col. 13, lines 37-50, [producing a target subscriber list from a

subset], Col. 13, lines 60-62, [transmitting the commercial information [represents

the list]).

As per claim 34, Saxe discloses:

wherein each of the prospective customers stored in the computer

database is assigned a unique known party ID, (Col. 4, line 49, [subscriber

customer identification])and wherein identifying the at least one other a prospect

list includes

identifying, in the database, prospective customers that have the same

known party ID as the known party ID assigned to at least one of the prospective

customers from the successful list of prospective customers for the first list

purchaser, (col. 4, line 55-col. 5, line 9, (matching identification to define more

targeted audience]).

As per claim 35, Saxe discloses:

Identifying, in the database, prospective customers having at least one

attribute similar to at least one attribute of at least one of the prospective

customers from the successful list of prospective customers for the first list

purchaser, (Col. 11, lines 19-23, [similar characteristics]).

As per claim 37, Saxe discloses:

removing duplicate prospective customers from the targeted list of

prospective customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 38, Saxe discloses:

distributing the targeted list of prospective customers to the first list

purchaser, (Col. 3, lines 3-13, [distributors advertising messages and accessing

targeted subscribers]).

As per claim 39, Saxe discloses:

distributing the targeted list of prospective customers to a third party

associated with the first list purchaser, (Col. 13, lines 8-61, [shows process for

third party source]).

As per claim 40, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the

first list purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 41, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on

a storage medium and delivers the storage medium to the first list purchaser,

(Col. 4, lines 7-14, [subscriber data stored]).

As per claim 42, Saxe discloses:

further comprising soliciting feedback from the first list purchaser to evaluate success of the targeted list provided to the first list purchaser, (Col. 6, lines 42-45, [shows directory's information can come from local surveys)].

As per claim 43, Saxe discloses:

further comprising storing the feedback from the first list purchaser in the computer database, (Col. 6, line 37, [shows survey information is updated in the directory]).

As per claim 45, Saxe discloses:

identify, in a computer database of prospect lists, a successful list of prospective customers that was used by the first list purchaser and that is associated with data indicating that the list was successful for the first list purchaser based on feedback from the first list purchaser, (Col. 12, lines 42-45, [matching with the database to identify target subscriber listing], w/(Col. 12, lines 32-45, [matches with the database to identify target subscriber listing, (Col. 8, lines 59-65, [subscriber responses provided represents feedback, list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list]);

identify, in the computer database, at least one other prospect list that includes at least one of the prospective customers included in the successful list of prospective customers for the first list purchaser, (Col. 12, lines 46-47, (providing control signal for subscriber [represents the list purchaser], (Col. 13, lines 42-50, [where successful prospect lists are represented by the target

subscriber lists that matches the customer information], w/(Col. 12, lines 48-51,

[commercial information being transmitted to the subscriber], (Col. 13, lines 42-

50, [where successful prospect lists are represented by the target subscriber lists

that matches the customer information], (Col. 12, lines 42-45, [matching with the

database to identify target subscriber listing where the subscriber represents the

customer], Col. 8, lines 48-65, [viewers {subscribers} may interface with the cable

medium in order to interact where appropriate, and responses are captured on a

file server, thereby allowing viewer {subscriber} access to this response

information. In addition, the subscriber responses provided represents feedback,

and the list of respondees to targeted advertisements identified by a buy number

who desire product information indicates a successful list]); and

provide access to a targeted list of prospective customers, including one

or more prospective customers from the set of additional prospect list, to the first

list purchaser, (Col. 12, lines 48-51, [commercial information being transmitted to

the subscriber], w/(Col. 13, lines 37-50, [producing a target subscriber list from a

subset], Col. 13, lines 60-62, [transmitting the commercial information [represents

the list]).

As per claim 46, Saxe discloses:

wherein each of the prospective customers stored in the computer

database is assigned a unique known party ID, (Col. 4, line 49, [subscriber

customer identification]) and further comprising processing instructions for

directing the computer to

identify prospective customers stored in the database having the known

party assigned to prospective customers from the successful list of the first list

purchaser, (col. 4, line 55-col. 5, line 9, (matching identification to define more

targeted audience]).

As per claim 47, Saxe discloses:

wherein the processing instruction s for directing the computer to identify

the at least one other prospect list includes processing instructions for directing

the computer to

identify, in the database, prospective customers having at least one

attribute similar to at least one attribute of at least one of the prospective

customers from the successful list of prospective customers for the first list

purchaser, (Col. 11, lines 19-23, [similar characteristics]).

As per claim 49, Saxe discloses:

further comprising processing instructions for directing the computer to

removing duplicate prospective customers from the targeted list of prospective

customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 50, Saxe discloses:

further comprising processing instructions for directing the computer to

solicit feedback from the first list purchaser to evaluate success of the

targeted list provided to the first list purchaser, (Col. 6, lines 42-45, [shows

directory's information can come from local surveys)].

As per claim 51, Saxe discloses:

further comprising processing instructions for directing the computer to

store the feedback from the first list purchaser in the computer database, (Col. 6,

line 37, [shows survey information is updated in the directory]).

Response to Arguments

8.   Applicant's arguments filed 5/19/04 have been fully considered but they

are not persuasive.

As per claim 1, the applicant argues that Saxe does not provide a

database of prospect lists, i.e., a database that includes lists of prospective

customers, in which each such list is associated with data that indicates whether

the list was successful based on feedback from a list purchaser. However, Saxe

discloses this limitation. Specifically, in Col. 12, lines 32-45, Saxe discloses

matching with the database to identify target subscriber listing. In this case, the

target subscriber listing identified from matching with the database represents the

database of prospect lists. In addition, Col. 8, lines 59-65, Saxe discloses that

subscriber responses to TEA-placed advertisements are provided, which results

in a list of respondees to targeted advertisements identified by a buy number who

desire product information indicates a successful list. In this case, the subscriber

responses represent the feedback, and the list of respondees to targeted

advertisements represented by a buy number who desire product information

represents a successful list. Since Saxe provides a database of prospect lists as

described above, Saxe also teaches *identifying in the database one or more*

other list purchasers, identifying in the database successful lists for the other list

purchaser, and providing access to a targeted list that includes one or more of

those successful lists.

The applicant also argues that Saxe does not disclose one or more other

list purchasers by identifying a company who has used one of the successful

lists for the first company and therefore, according to applicant, does not teach

identifying one or more other list purchasers who used one or more of the

successful lists for the first list purchaser. However, as described in the

preceding paragraph, Saxe discloses providing access to a targeted list of

customers. In addition, in Col. 8, lines 48-65, Saxe discloses that viewers

{subscribers} may interface with the cable medium in order to interact with

responses to TEA-placed advertisements where appropriate. In this case, the

responses are captured on a file server, thereby allowing viewer {subscriber}

access to this response information. Since the response information is shown to

result in a list of respondees who desire product information (successful list), this

access by the subscriber represents a list purchaser accessing a successful list.

The applicant also argues that Heinly does not identify one or more other

list purchasers. However, it is the *combination* of Saxe and Heinly that teach the

identification of one or more other list purchasers. As shown above, Saxe

discloses the identity of one or more other list purchasers. Heinly was

introduced to show the usage of one or more of the one or more successful lists.

This is shown in Heinly on Page 2, paragraph 14, lines 1-2, where a "prospect

list" of former customers and of nonbuying "traffic" is maintained to target

potential buyers. Heinly discloses this limitation to show that a prospect list can

be determined from previous successful lists such as prospect lists of former

customers.

Since claims 2-8 depend from claim 1, claims 2-8 are also rejected for the

same reasons as discussed above with respect to claim 1.

Independent claims 9, 14, 33, 45 and 53 are directed to methods,

computer-readable storage media, and systems and include features similar to

those of independent claim 1, and are therefore rejected for the same reasons.

Independent claims 10-13, 17, 18, 32-43, 46-52, 56 and 57 depend therefrom,

and are also rejected for the same reasons.

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection

presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as

set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

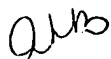calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.
August 24, 2004

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600